

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by adding a pH limitation, as supported in the specification at page 23, lines 1-3; by adding a component (C), as supported in the specification at page 22, lines 11-13; and by deleting the weight ratio of (A) to (B).

New Claim 18 has been added, and is supported in the specification at page 22, lines 11 and 13, and by Table 1.

No new matter is believed to have been added by the above amendment. Claims 1-18 are now pending in the application.

REMARKS

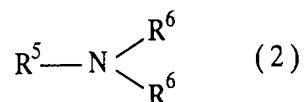
Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2005/0255074, when discussing the application description, rather than to page and line of the specification as filed.

The rejection of Claims 1, 3, 9, 11, 13 and 17 under 35 U.S.C. § 103(a) as unpatentable over “combined teachings of” US 6,086,663 (Kondo et al) and JP 1997-151119 (Ando et al), is respectfully traversed.

As recited in above-amended Claim 1, an embodiment of the present invention is a hair cosmetic comprising the following components (A), (B) and (C):

(A) organopolysiloxane having an amino-modified organopolysiloxane chain and a polyoxyalkylene chain,

(B) a tertiary amine compound represented by formula (2):



wherein R⁵ represents a linear or branched alkyl or alkenyl group containing 8 to 35 carbon atoms in total, which may be interrupted by a functional group represented by -O-, -CONH-, -OCO- or -COO- or substituted with -OH; R⁶ represents a C1 to C22 alkyl, alkenyl or hydroxyalkyl group, and two R⁶s may be the same as, or different from, each other,

(C) at least one compound selected from the group consisting of malic acid, succinic acid, maleic acid, salicylic acid, malonic acid, mandelic acid, lactic acid, glycolic acid and salts thereof,

wherein the hair cosmetic has a pH of 3 to 5.

At the recited pH, the tertiary amine is cationic.

The hair cosmetic of the present invention is disclosed as useful in suppressing a frictional feeling of hair during rinsing in running water and improving the softness and smoothness of hair during rinsing, as described in the specification at paragraph [0001].

As described in the specification at paragraph [0003], conventionally, cationic compounds such as cationic surfactants and cationic polymers, lubricants, silicones, etc. have been used to improve smoothness during rinsing, but the effect of the cationic surfactants and polymers on suppression of a feeling of a friction in water is limited, and is poor in an ability to confer softness and smoothness. The lubricants hardly suppress a feeling of friction in running water, and dimethyl polysiloxane can be said to be absent in an ability to suppress a feeling of friction in running water and in an ability to confer softness and smoothness. Among the silicones, a polyether-modified silicone is poor in an ability to confer a feeling of softness, and the ability thereof to suppress a feeling of friction and to confer smoothness is not durable. An amino-modified silicone can confer a lasting feeling of softness, but cancels the feeling of selfness because of its feeling of friction similar to the feeling of strong rubber in running water.

The present invention addresses the problems of the prior art.

The Examiner holds that it would have been *prima facie* obvious to have incorporated the amino-modified organopolysiloxane component of Ando et al into the invention practiced by Kondo et al, particularly since both inventions are directed to the creation of cosmetic compositions, more specifically hair care products.

In reply, even if Ando et al were combined with Kondo et al, the result would still not be the presently-claimed invention. Neither Ando et al nor Kondo et al disclose or suggest any of the acids within the terms of present component (C), or a pH of 3 to 5. Kondo et al discloses no acid and no pH. In their list of applicable additives for their hair cosmetic ingredient, Ando et al does not list any acid (paragraph bridging pages 15 and 16). The only

acid disclosed by Ando et al is citric acid, in Tables III and VII, and for adjusting the pH at 5.8. Thus, Ando et al actually teaches away from a pH of 3-5.

In addition, Applicants incorporate by reference the arguments made in the previous response.

In response to Applicants' argument that one of ordinary skill in the art would not rely on Comparative Example 6 of Kondo et al, and that it would be discarded as, in effect, a failed experiment, in view of its inferiority compared to the inventive **amide** polyether-modified organopolysiloxane invention of Kondo et al, the Examiner finds that said Comparative Example 6 "teaches and suggests Applicants' instantly claimed composition. That is the composition is made known in the art regardless of its qualities."

In reply, the Examiner has never found that Comparative Example 6 of Kondo et al anticipates the present invention. Indeed, it does not, even before the above-discussed amendment. However, in view of the above-discussed amendment, there is even less motivation to further modify Kondo et al. Nor is there any evidentiary support for the Examiner's finding that Q¹ in the amide polyether-modified organopolysiloxane of Kondo et al suggests the tertiary amine compound of formula (2) of the present claims. It is simply incongruous for the Examiner to rely on the inferior and non-inventive amino-modified polysiloxane of Kondo et al for one purpose, and the inventive amide polyether-modified polysiloxane of Kondo et al for another purpose, all to support the present rejection.

Nor has the Examiner made any findings on the comparative data in the specification discussed in the previous Office Action. As stated therein, the applied prior art could not have predicted the improved results obtained when using presently-recited component (A), as shown by Products of the Invention 4 and 6-8 herein, compared to Comparative Product 3 which, instead of component (A) herein, employ either a dimethylpolysiloxane; the dimethylpolysiloxane and an amino-modified polysiloxane; a polyether modified

polysiloxane; and the amino-modified polysiloxane, respectively. Compare the evaluation data in Table 1 for the Products of the Invention with the evaluation data in Table 2 for the Comparative Products at paragraphs [0106] and [0107] of the specification.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 16 under 35 U.S.C. § 103(a) as unpatentable over Kondo et al and Ando et al, further “in combination with” US 5,078,990 (Martin et al), is respectfully traversed.

Martin et al discloses an aqueous shampoo comprising particular sulfate anionic and quaternary ammonium cationic surfactants that increase the ability of the shampoo (1) to incorporate water-insoluble conditioning agents, particular non-volatile silicone materials, and (2) to remove previously applied conditioning agents and contaminants from the hair (column 4, lines 24-34). Conditioning agents that may be incorporated include such non-volatile silicone materials and, *inter alia*, polysiloxane polydimethyl dimethylammonium acetate copolymers, amino functional silicones, and fatty amido amines such as stearamido propyl dimethylamine (column 10, line 59 to column 11, line 12).

The Examiner holds that it would have been *prima facie* obvious to, in effect, incorporate stearamido propyl dimethylamine of Martin et al into the composition resulting from the combination of Kondo et al and Ando et al.

Without the present disclosure as a guide, one of ordinary skill in the art would not have combined Martin et al with Kondo et al and Ando et al but even if combined, the result would still not be the presently-claimed invention. The deficiencies in the combination of Kondo et al and Ando et al have been discussed above; Martin et al does not remedy these deficiencies. Indeed, Martin et al discloses and suggests nothing with regard to the presently-recited pH range or the presence of present component (C).

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 17 under 35 U.S.C. § 112, second paragraph, and the objection thereto, are respectfully traversed. Indeed, the rejection and objection are now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection and objection be withdrawn.

Applicants continue to respectfully traverse the Restriction Requirement. As previously stated, the fact that presently-recited component (A) may not be novel *per se*, does not mean that the claims do not relate to a single general inventive concept under PCT Rule 13.1. Indeed, the special technical feature of the present invention is the **combination** of components (A), (B) and (C). In addition, given the breadth of the disclosure in Ando et al of the reactive silicone-type block copolymer therein, there would appear to be little or no burden to examine all of the present claims.

In the present Office Action, the Examiner simply repeats his reliance on Claim 1 of Ando et al and maintains that the claims do not relate to a single inventive concept under PCT Rules 13.1 and 13.2.

In reply, the Examiner has not specifically addressed the above argument that the special technical feature of the present invention is not component (A) *per se*, but the combination of components, nor has the Examiner addressed the argument that there would appear to be little or no burden to examine all of the present claims.

In addition, the Restriction Requirement is still not clear. Indeed, it is internally inconsistent. Thus, Claims 3 and 9, which are active, limit component (A) to a block copolymer, but Claims 4, 5, 7 and 8, which are withdrawn, also limit component (A) to a block copolymer. Active Claim 9 and withdrawn Claim 8 recite the same unit represented by formula (4). Indeed, the withdrawn claims simply are drawn to a narrower embodiment regarding component (A). There is no justification for restricting out, in effect, a preferred species or subgenus from a genus.

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Reply to Final Office Action of November 25, 2009

Therefore, Applicants respectfully request that the Restriction Requirement be withdrawn, and all of the presently-pending claims be examined on the merits.

Applicants respectfully submit that all of the presently-pending claims are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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